

**IN THE MATTER OF AN OPPOSITION  
by Rickitt Benckiser N.V. to application  
no. 885,247 for the trade-mark  
LIME OUT filed by Iron Out, Inc.**

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On July 23, 1998, the applicant Iron Out, Inc. filed a Canadian trade-mark application to register the mark LIME OUT based on intended use of the mark in Canada for the following wares:

general purpose cleaning preparations for preventing  
and removing mineral deposits and odors.

The applicant claimed July 20, 1998 as a priority filing date for Canada, based on Section 34 of the *Trade-marks Act*, in view of its parallel trade-mark application filed earlier in the United States.

The Examination Section of the Trade-marks Office advised the applicant that the component LIME would have to be disclaimed apart from the mark as a whole. The Examination Section raised a further objection that the applied for mark LIME OUT was not registrable in view of the extant registration LIME-A-WAY, no.136, 865, covering "organic acid detergent." The applicant filed a revised application to disclaim the offending word portion LIME in response to the first objection. The applicant further submitted that the cited mark LIME-A-WAY is a weak mark, that there are significant differences in the wares covered by the marks, and that the channels of trade for the wares covered by the marks are different. The Examination Section accepted the applicant's amended application and submissions. The subject application was subsequently advertised for opposition purposes in the *Trade-marks Journal* issue dated September 20, 2000,

and was opposed on November 20, 2000, by Benckiser N.V, the owner of the mark LIME-A-WAY referred to above. During the course of these proceedings Benckiser N.V changed its name to Rickitt Benckiser N.V.

The first ground of opposition alleges that the subject application does not comply with Section 30(i) of the *Trade-marks Act* because, at the date of filing the application, the applicant was aware that it was not entitled to use the applied for mark in association with the wares specified in the application.

The second ground of opposition, based on Section 12(1)(d) of the *Act*, alleges that the applied for mark is confusing with the opponent's registered marks LIME-A-WAY, referred to above, and LIME-A-WAY & Design, regn. no. 524,984, detailed below:



The applicant claims the colours green, orange, black and white as essential features of the trade-mark. In particular, the triangle shaped top portion of the design and the triangular shaped bottom portion of the design are in the colour green. In addition, the top half portion of the rectangular element at the top of the design is also green as are the four (4) characters and the comma in the lower left hand side of the design. The five (5) characters on the lower right hand side of the design are orange. Otherwise, the colours of the design are black and white as depicted in the drawing of the trade-mark.

wares

bleaching preparations and other substances for laundry use,  
namely laundry whitener, laundry neutralizer, laundry

conditioning preparations, laundry de-staining preparations,  
laundry rust remover and laundry rinse agents;  
all purpose polishing, scouring and abrasive preparations;  
laundry detergents.

The third ground of opposition, based on Section 16(3)(a) of the *Act*, alleges that the applicant is not entitled to register the mark LIME OUT because it is confusing with the opponent's marks LIME-A-WAY used in Canada since 1960 and LIME-A-WAY & Design used in Canada since 1989.

The fourth ground of opposition alleges that the applied for mark is not adapted to distinguish the applicant's wares in view of the opponent's prior use of its marks.

The applicant responded by filing and serving a counter statement. The opponent's evidence consists of the affidavit of Andrew M. Hedges, General Manager of Reckitt Benckiser (Canada) Inc. The applicant's evidence consists of the affidavit of John Didier, Chief Financial Officer of the applicant company; and the affidavit of Jo-Anne Kennedy, legal assistant. Both parties submitted written arguments. The opponent requested and was granted leave to file additional evidence namely the affidavit of Heather Allen, a successor General Manager of Reckitt Benckiser (Canada) Inc.: see the Board ruling dated April 8, 2005. Both parties were represented at an oral hearing.

Mr. Hedges' affidavit evidence may be summarized as follows. Mr. Hedges is the General Manager of Reckitt Benckiser (Canada) Inc. According to Mr. Hedges, his company has sold

laundry preparations as well as abrasive preparations in Canada under the opponent's trade-marks since 1960. Sales in Canada, through various retail outlets including supermarkets and hardware outlets, amounted to about \$1.5 million in 1996 rising to about \$2 million in 2000 for total sales of about \$9 million for the five year period 1996 -2000. No breakdown is given to differentiate sales of laundry preparations from sales of abrasive preparations. Advertising expenses for the opponent's wares under its marks LIME-A-WAY and LIME-A-WAY & Design, via television and print media, amounted to about \$5.5 million for the five year period 1996-2000. I note that no breakdown is given to differentiate between use (or advertising) of the opponent's word mark LIME-A-WAY and the opponent's design mark regn. no. 524,984. In any event, I consider that use of the design mark is equivalent to use of the word mark given the prominence of the word portion in regn. no. 524,984: in this regard see *Nightengale Interloc v. Prodesign Ltd.* (1984), 2 C.P.R.(3d) 535 at 538 under the heading *Principle 1*.

Ms. Allen's affidavit evidence is that Reckitt Benckiser (Canada) Inc. (as well as another company namely, Reckitt Benckiser Inc.) is a subsidiary of the opponent Rickitt Benckiser N.V., and that Reckitt Benckiser (Canada) Inc. uses the opponent's LIME-A-WAY trade-marks under license from the opponent. A copy of the license agreement ( effective as of January 1, 2002) indicates that the opponent has control over the quality of the wares sold by Reckitt Benckiser (Canada) Inc. under the LIME-A-WAY marks.

The applicant has correctly pointed to lacuna in the opponent's evidence and urges me to

find that use of the mark LIME-A-WAY described by Mr. Hedges does not accrue to the benefit of the opponent. The applicant's objections are not without merit, however, on a fair reading of the opponent's evidence taken as a whole, and in the absence of cross-examination which might have illuminated the applicant's concerns, I find that use of the LIME-A-WAY marks by Reckitt Benckiser (Canada) Inc. inures to the benefit of the opponent pursuant to Section 50(1) of the *Trade-marks Act*.

Mr. Didier's evidence, filed on behalf of the applicant, may be summarized as follows. The applicant sells cleaning preparations under the mark LIME OUT. The applicant's products are intended to prevent and remove mineral deposits and odours. The applicant first began to sell its products in Canada in December 1999 and in the United States in July 1998. Sales in Canada amounted to about \$100,000 by August 12, 2002 (apparently the date of Mr. Didier's affidavit). Products bearing the applicant's LIME OUT mark are sold across Canada through a number of retail outlets including Home Depot, Home Hardware, Canadian Tire, Sobeys, Safeway and Wal-Mart. The applicant's wares sold under its mark LIME OUT have been brought to the attention of merchandisers through trade publications such as *Hardware Merchandising* and *Quart deRond*, and to the attention of the general public through widespread distribution of discount coupons. The exhibit material attached to Mr. Didier's affidavit shows that the applicant also sells cleaning and laundry products under its marks IRON OUT (removes rust), RUST OUT (removes rust), YELLOW OUT (laundry whitener), DRAIN OUT (drain maintenance) and WHIRLOUT & Design (whirlpool cleaner). The affidavit of Jo-Anne Kennedy confirms that the applicant is the owner of Canadian trade-mark registrations for several of the above-mentioned marks. However, the

applicant's ownership of a family of "OUT" marks does not assist the applicant in the absence of evidence that the public has become acquainted with those marks. Such evidence is absent in the instant case.

The jurat at the foot of Mr. Didier's affidavit is incomplete in not mentioning the location or exact date, apart from the year 2002, of swearing while exhibits to the affidavit are properly commissioned and are dated August 12, 2002. The opponent does not argue that Mr. Didier's affidavit is inadmissible in these proceedings, but, in its written argument and at the oral hearing, takes the position that the affidavit should be given reduced weight. I disagree. If there is no objection to the affidavit being admitted into evidence, then I do not see why deficiencies in the jurat should effect the weight given to the contents of the affidavit. The opponent also objected for the first time in its written argument that the affidavit material attached to the Kennedy affidavit should be considered inadmissible or given low probative value because the exact date of commission is incomplete. In this regard, the date of commission of the exhibits erroneously reads "the day of July, 2002" while the date of the affidavit itself reads "the 17 day of July, 2002." As the opponent's objection was raised very late in the proceedings, effectively depriving the applicant an opportunity to perfect its evidence, I will treat the error as a technical deficiency without adverse consequences for the applicant.

The main issue in this proceeding is whether the applied for mark LIME OUT is confusing with the opponent's mark LIME-A-WAY. The legal onus is on the applicant to show that there

would be no reasonable likelihood of confusion, within the meaning of Section 6(2), between the applied for mark LIME OUT and the opponent's mark LIME-A-WAY. The presence of an onus on the applicant means that if a determinate conclusion cannot be reached once all the evidence is in, then the issue must be decided against the applicant: see *John Labatt Ltd. v. Molson Companies Ltd.* (1990) 30 C.P.R.(3d) 293 at 297-298 (F.C.T.D.). The test for confusion is one of first impression and imperfect recollection. Factors to be considered, in making an assessment as to whether two marks are confusing, are set out in Section 6(5) of the *Act*: the inherent distinctiveness of the marks and the extent to which they have become known; the length of time each has been in use; the nature of the wares, services or business; the nature of the trade; the degree of resemblance in appearance or sound of the marks or in the ideas suggested by them. This list is not exhaustive; all relevant factors are to be considered. All factors do not necessarily have equal weight. The weight to be given to each depends on the circumstances: see *Gainers Inc. v. Tammy L. Marchildon and The Registrar of Trade-marks* (1996), 66 C.P.R.(3d) 308 (F.C.T.D.).

The material dates to consider the issue of confusion are (i) the date of decision with respect to the second ground of opposition alleging non-registrability pursuant to Section 12(1)(d); (ii) the date of filing the application, that is, July 23, 1998, with respect to the third ground of opposition alleging non-entitlement pursuant to Section 16(3)(a) and; (iii) the date of opposition, that is, November 20, 2000 with respect to the last ground of opposition alleging non-distinctiveness: for a review of case law concerning material dates in opposition proceedings see *American Retired Persons v. Canadian Retired Persons* (1998), 84 C.P.R.(3d) 198 at 206 - 209 (F.C.T.D.). In any event, in the instant case I do not believe that

anything turns on whether the issue of confusion is determined at any particular material date.

The opponent's mark LIME-A-WAY, used in association with laundry preparations and detergents, is suggestive of a product that removes mineral deposits. It is therefore an inherently weak mark. The opponent has evidenced that its mark LIME-A-WAY acquired some distinctiveness in the market place, at all material dates, through sales and advertising. However, the evidence is far from sufficient to establish a significant reputation for the mark. Further, it is not clear from the evidence which of the opponent's various products sold under the mark LIME-A-WAY would have received the greatest attention from the public. The applied for mark LIME OUT is similarly a weak mark. The applied for mark cannot claim any acquired distinctiveness at the earliest material date although some distinctiveness was acquired through use and advertisement by the later material dates. The length of time that the marks in issue have been in use favours the opponent but only to a limited degree as the opponent has not evidenced the extent of use of its mark LIME-A-WAY prior to 1996. From the limited evidence filed by the parties concerning the nature of their wares, I conclude that the opponent sells some products under its mark LIME-A-WAY that are intended to perform the same function as the cleanser sold by the applicant under its mark LIME OUT. However, from the sparse evidence filed by the opponent, it is not possible to isolate the extent of sales of a particular product. In any event, I would expect the parties' wares to be sold through similar channels of trade and might well be sold side by side at retail outlets for certain of the opponent's products. The parties' marks resemble each other to a fair extent visually and aurally owing to the component LIME which is the prefix common to both



marks. The marks in issue also resemble each other to a fair extent in ideas suggested as the terms A-WAY and OUT, in the context of cleaning products, both suggest that stains will be removed.

Considering the above, and keeping in mind in particular that the opponent's mark LIME-A-WAY is a relatively weak mark and that the opponent has not established a significant reputation for its mark for the particular task of removing mineral deposits, I find that the differences between the parties' marks suffice to avoid confusion. In so finding I am applying the following principle set out in *Cochrane-Dunlop Ltd. v. Capital Diversified Ltd.* (1976) 30 C.P.R.(2d) 176 at 182-183 (Ont. C. A): The ambit of protection afforded to a weak mark is much less than for a strong mark, and registration of other marks containing comparatively small differences may be permitted.

In view of the foregoing, the opponent's opposition is rejected.

DATED AT GATINEAU, QUEBEC, THIS 11th DAY OF OCTOBER, 2005.

Myer Herzig,  
Member,  
Trade-marks Opposition Board